UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,467	07/25/2003	Yoshihisa Funamoto	5267-55PCON2	3230

		EXAMINER
7590	06/23/2005	LEE, DIANE I

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ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _7/25/03 (Preliminary Amendment)_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-29_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-29_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☒ Certified copies of the priority documents have been received in Application No. _10/282,376_.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _7/03, 3/04_.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Receipt is acknowledged of the Amendment filed 25 July 2003. Claims 1, 12, 19, 23,

and 27-28 have been amended; no claims have been canceled, and no claims have been newly

added. Accordingly, claims 1-29 are pending in the application.

Priority

2.   Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-

(d). The certified copy has been filed in parent Application No. 10/282,376, filed on 29 October

2002.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5.   **Claims 1-6, 10-11, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber et al. [US 2002/0004746 A1-referred as Ferber, cited by the applicant] in view of Nikkei Business Journal [referred as NBJ, also cited by the applicant].**

Re claims 1-3: Ferber discloses an identification bar code assigning device, the identification bar code assigning device comprising:

a user with a wireless device 100 (a mobile phone) as a party having an account with an e-coupon server;

wherein the wireless device 100 includes a transceiver (not specifically shown) to carry out a wireless communication with e-Coupon server (see sec. 21 and figure 1);

the wireless device 100 initiating a communication in an electronic commerce environment, i.e., the party establishing the communication channel with an e-coupon server 106 via a wireless Web provider 102 and an Internet 104 having a plurality of known communication channels 200-206 to carry out functions such as downloading a useful data from the server (i.e., the wireless device 100 establishes the communication channel with e-coupon server 106 to download the e-coupons). This process includes a login step, which inherently includes the step of uploading the sender number, i.e., the identification information of the wireless device 100 to identify the wireless device 100 to the network carrier;

receiving means (not specifically shown) in the server 106 for receiving request signal from the user, i.e., uploading data from the party, for desiring identity verification and requesting e-coupon data signal having an identification bar code 400 to be downloaded for a redeeming purpose to the sender number of the party, which also teaches the data signal transmitted from the server 106 includes the sender number of the party (see sec. 25);

the e-coupon server 106 transmits the e-coupons in a machine readable bar code 400 to

the wireless device 100 which inherently teaches that the e-coupon server 106 having a bar

code generating means responsive to the bar code request signal for generating a bar code for

the party;

a user profile database 108 as a bar code database for recording and storing the e-

coupon data generated by the bar code generating means and transmitted to the party (see

figure 1); and

the wireless device displays the generated bar code on a screen 410 (see sec. 25 and

figure 4).

Ferber does not teach that generated bar code is unique to the party desiring identity

verification.

NBJ teaches a method of settlement of account between a party having a portable

telephone and a store through portable telephone. In NBJ discloses that a bar code is assigned

to each portable telephone purchaser (i.e., step of storing the customer data in the system), and

the bar code is called upon the screen of the portable telephone every time he/she visits to a

store (i.e., the stored customer data is stored in the system, and is generated to the screen of

the portable telephone in a bar code format). Therefore, the account can be settled without

involving cash or a credit card by having a salesperson reading the bar code from the portable

telephone using a bar code reader. The bar code called upon the screen of the telephone by

the customer being utilized for settling account in lieu of credit card, which obviously includes

the step of checking whether the received signal from the customer with the stored data of

system, wherein the bar code information includes user's unique information, i.e., user's

identification information and account information of the user. Therefore, NBJ obviously

teaches the step of generating a bar code only unique to the party desiring identity verification for transaction settlement.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of NBJ (i.e., step of generating a bar code unique to the party desiring identity verification) in the system of Ferber in order to provide a bar code that identifies the customer in addition to generating the e-coupon bar code to the user in the account settlement process. Such modification would have provided Ferber a complete paperless transaction system (i.e., the customer does not required to present a credit card at the store when making a purchase and obtaining a redemption).

Re claims 4 and 28-29: Ferber teaches the wireless device 100 having an account with e-coupon server and performs login operation with the e-coupon server, including the steps of retrieving the user's consumer profile from the database, choosing from a coupon selection, and other criteria are performed. This operation obviously teaches the steps of discriminating whether the party having an account with the server and whether party's profile is recorded in the database 108; and transmits the e-coupon bar code signal to the wireless device to be displayed on the display device 410 when the party's profile is recorded in the database (see sec. 25).

Re claim 5: when the party is new, i.e., the party does not have an account with the e-coupon server and thus does not recorded in the server, then the system informs the party by providing an initial account information to the wireless device (see sec. 26).

Re claim 6: the wireless device being informed and provided the initial account information to the wireless device by the server (see sec. 26). This process of providing initial account information to the wireless device is equivalent to sending the party a message advising the party to sign up.

Re claims 8 and 9: Although Ferber does not specifically state the sender number is a mobile phone number or a fixed phone number of the party, the fact that the Ferber teaches the wireless device is mobile phones (see sec. 21), it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that the uploaded information from a mobile phone would obviously include the mobile phone number or a fixed phone number of the party to be identified by the network carrier when the mobile phone establishes the communication channel to access the server. Therefore, the download data of the e-coupon would be transmitted to the specific mobile phone, which identified by the network carrier.

Re claim 10-11: see sec. 25 and figure 4.

6.   **Claims 7 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber as modified by NBJ as applied to claim 1 above, and further in view of Koenck [US 5,979,768, cited by the applicant].** The teachings of Ferber as modified by NBJ have been discussed above.

Ferber as modified by NBJ does not specifically teach the device having a bar code database for specifically storing the bar code data.

Koenck discloses a memory for storing the pixel image of the bar code (i.e., generated bar code image of the bar code. (see col. 3, lines 1+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the memory for storing the pixel image of the bar code in the system of Ferber as modified by NBJ order to eliminate addition code conversion process (i.e., converting e-coupon data to a machine readable bar code image data) in an event that user

prefers the same e-coupon previously downloaded. Accordingly, such modification would have

expedited the downloading operation of the e-coupon data to the party.

7.   **Claims 12-18 and 23-27 is rejected under 35 U.S.C. 103(a) as being unpatentable**

over Ferber in view of NBJ, Koenck and Nicholson [US 6,332,128, cited by the applicant].

The teachings of Ferber, NBJ, and Koenck have been discussed above.

Ferber teaches that the bar code 400 on the display device 410 of the wireless device is

scanned by coupon scanning devices (not shown) directly from the display for receiving the bar

code to obtain a NBJ teaches the step of generating a bar code unique to the party desiring

identity verification.

Koenck discloses a memory for storing the pixel image of the bar code (i.e., generated

bar code image of the bar code. The corresponding image pixels in the memory are used for

determining the validity of the bar cod image (see col. 3, lines 1+).

Ferber as modified by NBJ and Koenck does not teach the specifics of the coupon

redemption operation.

Nicholson teaches the system and method for generating and redeeming coupons,

comprising:

discriminating whether the received coupon coincides with stored coupon in the

database; and when the received coupon is one stored in the database, the system request the

customer to enter a personal identification number (PIN) to provide security (col. 4, lines 63+;

col. 6, lines 15+; and col. 9, line 62+).

It would have been obvious to an artisan of ordinary skill in the art at the time the

invention was made to incorporate the specific redemption operation taught by Nicholson in the

system of Ferber as modified by NBJ and Koenck in order to validate the coupon received by

the system with the coupon database and further identifies the user whether he or she is valid party. Accordingly, such modification would have increased tracking and inventory operation of the coupon redemption.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bone, Jr. [US 6,082,620], Mankovitz et al. [US 5,523,794], and Melick et al. [US 2002/0195495] discloses a system displaying bar code on the screen to be scanned by a scanner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. I. Lee
Primary Examiner
Art Unit 2876